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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

GRANT II, J

ART UNIT

PAPER NUMBER

2624

6

DATE MAILED:

01/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/218,335

Applicant(s)

Omi

Examiner

Grant

Group Art Unit
2624



☒ Responsive to communication(s) filed on Jan. 12, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-2-47 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-2-47 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/215,608.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

JEROME GRANT II
PRIMARY EXAMINER

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Detailed Action

1. Applicant's remarks have been considered but are unpersuasive to allow the claims for the reasons set forth in the **Examiners Response** below. The rejection is repeated

2. Applicant is required to surrender the "*defective patent*" as required by 35 U.S.C. 251 (or) submit an affidavit/declaration averring that the original patent is lost or misplaced.

3. Claims 12-47 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

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The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In a recent court decision, *In re Clement* (CAFC), 45 USPQ 2d 1161, the court used a three part test to determine the relevance of a prior art rejection in determining when claims in a reissue application may be properly broadened. See *Mentor Corp. V. Coloplast, Inc* 998 F.2d 992, 27 USPQ 2d 1521, (Fed. Cir. 1993) & *Ball Corp. v. United States*, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984).

From the courts reasoning, the following principles were applied:

1) if the reissue claim is as broad as or broader than the canceled or amended claim, in all aspects, the recapture rule bars the claim; 2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; 3) if the reissue claim is broader in some aspects, but narrower in other, then: a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, by narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; b) if the reissue claim is narrowing in an aspect germane to prior art rejection, and boarder in an aspect unrelated to the rejection, the recapture rule doe not bar the claim, but other rejections are possible.

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In the instant case, independent claims 12 and 30 recite an image forming system, comprising:

- a printer module;
- a scanner module.

In claims 12-29, however, the respective modules include limitations which narrow the scope thereof namely "... a first frame...." and "... a second frame different from the first frame..." and were not related to the rejections in the original case made by the examiner in the March 18, 1996 office action.

In claims 30-47, however, "...means for supporting elements of the printer module..." and "... means for supporting elements of the scanner module..." narrow the claims in scope and were not related to the rejections in the original case made by the examiner in the March 18, 1996 office action.

In distinction to claims 12 and 30 of the Reissue application, however, claim 1 of the original patent recites:

- a scanner module;
- a printer module;
- and a system control module.

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In comparison, claim 12 of the Reissue application broadens the scope but is narrower in aspect with the 1st and 2nd frame, than claim 1 (as amended March 18, 1996) of the original patent.

In comparison, claim 30 of the Reissue application is broader in scope but narrower in aspect of --means for supporting elements of the scanner/printer module-- than claim 1 of the original patent.

In conclusion, claims 12-47 are rejected under 35 U.S.C. Sect 251 para. 1 for lack of basis for Reissue application since said claims re barred in view of the June 17, 1996 amendment to claim 1 of the original patent, in accordance with the "*recapture rule*". See *Clements*, Id.

Examiner's Response

At page 3, lines 1-5, applicant states a first frame for a print module and a second frame for a scanner module, different from the first frame, was not previously presented. The examiner disagrees.

In claim 12, lines 2 and 6 of the Reissue application, it recites , "... a printer module, including: ... a first frame." Lines 7 and 12 of the same claim recites " a scanner module including: a second frame , different from the first frame..."

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In claim 1, line 18 of the parent application 08/215,608, it recites, "... a printer module formed as an independent frame..." At line 1 of the same, it states "... a scanner module formed as an independent frame." The recitation of the limitation above in claim 12 is synonymous with the above identified limitation of claim 1 of parent 08/215,608. The reissue claim 12 gives a new name to a previously established limitation, namely, the printer and scanner. Thus, any alleged difference between Reissue claim 12 and claim 1 of 08/215,608 regarding the printer and scanner and respective frames are inherent.

Thus, applicant's assertion at page 3, lines 1-5 is incorrect, since the features claimed have been previously recited under a different name.

The rejection of the claims is maintained by the examiner.

Applicant alleges that claims 30-47 recite a support means of the print module for supporting:
1) a generator; 2) a print control means; and 3) means for supplying power.

Applicant then alleges that claims 30-47 recite a scanner module supporting:
1) scan control means and 2) scan means.

However, claim 1, lines 1-3 and claim 6, line 1-3 recite "a scanner module formed as an independent frame, comprising..." This language suggests that the "**independent frame**" is

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independent from an other frame and will support the elements upon which the scanner module is comprised of. Subsequently, the scanner module comprises the scan means, referred to as “ an image reading means” (line 4) and scan control means, referred to as “ first synchronizing signal generating means “ (fourth limitation of respective claims).

Therefore, the scanner module, includes a frame which supports the scan means and scan control means.

Claim 1, line 18 recites, “... a printer module formed an independent frame, comprising...” This language suggest that the “independent frame” is independent from any other frame and will support the elements upon which the printer module is comprised of. Subsequently, the printer module comprises: the generator, referred to as “ the image forming means...” (Claims 1 and 6 at lines 20-23); print control, referred to as “.. Second synchronizing signal generation (claims 1 and 6, lines 26-28); and power supply means having input and output means, which refers to “ second data I/O means...” (Claim 1, lines 23-25 and claim 6 lines 22 and 23). Thus, the difference between the Reissue claim 30 and claims 1 and 6 of 08/215,608 is merely phraseology (verbiage). The same elements and structured limitation are described using different language.

Applicant cites Mentor Corp. V. Coloplast, Inc., 998 F.2d 992, 994, 27 USPQ 2d 1521, 1524 (Fed. Cir. 1993). The Federal Circuit held that merely describing a member as a “flexible” or “single roll” does not materially narrow the claim to escape recapture. The examiner concurs. In

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is (703) 305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore, can be reached on (703) 308-7254. The fax phone number for this Group is (703) 306-5406.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

J. Grant II
Jan. 9, 2001

JEROME GRANT II
PRIMARY EXAMINER



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